

REMARKS

Summary

Claims 1-3 were pending. Claim 3 has been withdrawn in response to a restriction requirement, and Claims 1 and 2 were rejected in the present Office Action. New Claims 4-20 have been introduced to further describe subject matter to which the Applicants are entitled. No new matter has been introduced. The Applicants have carefully considered the references and the reasons set forth by the Examiner for the rejections, and respectfully traverse the rejections.

Claim Rejections

35 U.S.C. § 112, second paragraph

Claim 2 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. Claim 2 has been amended to obviate the rejection.

35 U.S.C. § 103(a)

Claims 1 and 2 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Pugh, III (US 4,046,454; "Pugh") or Miller (US 3,864,018; "Miller") in view of Li et al. (US 6,377,732; "Li"). The Applicants respectfully submit that the Examiner has not made out a *prima facie* case of obviousness.

Claim 1 recites, *inter alia*, laminating metal-arranged thin films, each metal-arranged thin film comprising a dielectric thin film having a predetermined thickness and a plurality of fine metallic bodies arranged on the dielectric thin film.

The Examiner has not identified each of the elements and limitations in Claim 1 and associated each of them with a teaching in one of the references. Instead, the features of the references have been identified, without associating them with claim elements and limitations, and one cannot determine with any certainty what aspect of the present Claim 1 the Examiner refers to.

The Examiner asserts that "in view of the prior art teachings, it would have been obvious to fabricate a functional multilayer film with a metalized optical fiber because it enhances the bonding between the fiber and the substrate" (Office Action, page 4, lines 16-18). Yet there is no recitation in Claim 1 of a metalized optical fiber or the bonding of an optical fiber to a functional multilayer film.

Further, the Examiner asserts that "[b]oth Pugh and Miller are silent about the optical fiber is a metal material" (Office Action page 4, line 10), and depends on Li to remedy this deficiency in the case. It is well known in the art that optical fibers are composed of dielectric materials with appropriate refractive indexes, and are not metal. Hence, the fine metallic bodies of the arrangement of Claim 1 cannot be equated to optical fibers as the Examiner suggests. While Li teaches that the optical fiber may have a metallization evaporated thereon (Li, abstract), the relevance of a metal coated fiber to the "plurality of fine metal bodies" recited in Claim 1 has not been established by the Examiner.

As such, the asserted teachings of the references do not teach all of the elements of Claim 1 and therefore the Applicants respectfully submit that a *prima facie* case of obviousness has not been made out. Claim 2, being dependent on and further limiting an allowable independent claim, is allowable, without more.

NEW CLAIMS

New Claims 4-20 have been introduced to further claim subject matter to which the Applicants are entitled. Each of these claims is supported in the specification.

With respect to Claim 15, which incorporates the subject matter of Claims 1 and 3, the Applicants respectfully submit that this claim is an apparatus claim, which properly incorporates a recitation of the process by which some of the elements are fabricated. Such a claim construction is directed therefore towards the resultant apparatus, and is thus considered as part of one statutory class.

"[I]t is well established that product claims may include process steps to wholly or partially define the claimed product. See *In re Brown*, 59 CCPA ___, 459 F.2d 531,

535, 173 USPQ 685, 688 (1972), and the cases cited therein. To the extent these process limitations distinguish the *product* over the prior art, they must be given the same consideration as traditional product characteristics [emphasis in original].” *In re Luck*, 476 F.2d 844, 120 USPQ 523 (CCPA, 1973).

Claims 4-14 and 16-20 are directly or indirectly dependent on either Claim 1 or Claim 15, each of which is allowable, and the dependent claims are thus allowable, without more.

Conclusion

Claims 1-3 were pending; Claim 3 has been withdrawn; Claim 2 has been amended; and new Claims 4-20 have been introduced.

For at least the reasons presented above, the Applicants respectfully submit that the pending claims are in condition for allowance.

The Examiner is respectfully requested to contact the undersigned in the event that a telephone interview would expedite consideration of the application.

Respectfully submitted,



Anthony P. Curtis, Ph.D.
Registration No. 46,193
Agent for Applicants

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, ILLINOIS 60610
(312) 321-4200